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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,178

03/24/2004

Yoshiko Amitani

040150

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23850 7590 07/22/2008  
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EXAMINER

NGUYEN, JIMMY H

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

07/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,178	<b>Applicant(s)</b> AMITANI ET AL.	
	<b>Examiner</b> JIMMY H. NGUYEN	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. In view of the appeal brief filed on 5/6/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Bipin Shalwala/

Supervisory Patent Examiner, Art Unit 2629.

***Notice to Applicant***

2. The indications of features or the limitations of claims in the below objections and rejections are referred to the amendment after final filed on 12/19/2007 and entered by the examiner.

### ***Claim Objections***

3. Claim 5 is objected to because of the following informalities: “**the case**” in line 12 should be changed to -- the second case -- in order to clarify the claimed invention because there are two cases recited in the claim. Appropriate correction is required.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature, “**a part area**” in line 6 of **claim 1** and line 8 of **claim 5**, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

Art Unit: 2629

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to **claim 1**, this claim recites features, “at least a part area of front surface of the first case” in line 6, “the part area is exposed” in line 7, and “the part area of the first case” in line 8. Since it is unclear whether “a part area” of the feature in line 6, “the part area” of the feature in line 7, and “the part area” of the feature in line 8 are the same one, it is considered that the invention is not clearly defined.

Note that in the case that these part areas are different, there is insufficient antecedent basis for the limitation, “the part area” in line 7 or “the part area” in line 8, in the claim. In the case that these parts are the same one, “the part area is exposed” in line 7 should be changed to -- **said** part area is exposed -- and “the part area of the first case” in line 8 should be changed to -- **said** part area of the first case --, in order to clarify the claimed invention.

As to **claims 2-3**, since these claims depend upon claim 1, these claims are therefore rejected for the same reason set forth in claim 1 above.

As to **claim 5**, this claim recites the features, “at least a part area of front surface of the first case” in lines 7-8, “the part area is exposed” in line 9, and “the part area of the first case” in lines 9-10. Since it is unclear whether “a part area” of the feature in lines 7-8, “the part area” of the feature in line 9, and “the part area” of the feature in lines 9-10 are the same one, it is considered that the invention is not clearly defined.

Note that in the case that these part areas are different, there is insufficient antecedent basis for the limitation, “the part area” of the feature in line 9 or “the part area” of the feature in lines 9-10, in the claim. In the case that these parts are the same one, “the part area is exposed” in line 9 should be changed to -- **said** part area is exposed -- and “the part area of the first case” in lines 9-10 should be changed to -- **said** part area of the first case --, in order to clarify the claimed invention.

7. Further, in order to further consider these claims, examiner assumes that all “**part areas**” mentioned in the above rejection under 35 U.S.C. 112, second paragraph, are the same one.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-3 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to **claim 1**, this claim contains the limitation, “the second case is closable to a first posture wherein at least a part area of front surface of the first case is covered” in lines 5-6.

This limitation implies the part area (of front surface) of the first case being fully covered by the second case when in a first posture.

Claim 1 further recites a limitation, “the part area of the first case having a pointing device projecting therefrom in a direction apart from the front surface of the first case..., the second case having an opening extending through the case from the front surface thereof to the rear surface thereof at the position opposed to the pointing device when in the first posture, the opening having an inner peripheral wall to surround the entire pointing device” in last 6 lines.

This limitation implies that the pointing device is an element of the part area of the first case and is **not covered** by the second case in the first posture, thereby rendering **the part area of the first case not to be fully covered by the second case when in the first posture**.

Therefore, it is impossible to make a portable wireless terminal, which contains both limitations as discussed above. Accordingly, this claim contains the above underlined limitations, which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention.

Further, note that the invention of claim 1 is drawn to the embodiment illustrated by figures 1-3, as asserted by Applicant (see the Appeal Brief filed 5/6/2008; page 8). Figures 1-3 explicitly shows a pointing device (4) not being covered by the second case (2) either in the closed state (i.e., the claimed first posture) or in the opening state (i.e., the claimed second

posture), thereby rendering the claimed part area **not being fully covered** by the second case since the claimed pointing device is an element of the claimed part area.

As to **claims 2-3**, since these claims depend upon claim 1, these claims are therefore rejected for the same reason set forth in claim 1 above.

As to **claim 5**, since this claim similarly recites limitations of claim 1 as discussed in the above rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, this claim is therefore rejected for the same reason set forth in claim 1 above.

#### ***Response to Arguments***

10. Applicant's arguments, see the Appeal Brief, filed 5/6/2008, with respect to the rejection of claims 1-3 under 35 U.S.C. 103(a) as being unpatentable over Sassi (US 6,487,396 B1) in view of Kang et al. (US 7,146,197 B2) and the rejection of claim 5 under 35 U.S.C. 103(a) as being unpatentable over Kang et al. (US 7,146,197 B2) in view of Sassi (US 6,487,396 B1), have been fully considered and are persuasive. Therefore, the rejections in the Final Office Action dated 10/16/2007 have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as above.

#### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 3:00 p.m..



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629